

Application No. 10/688,370
After Final Office Action of January 9, 2006

Docket No.: 03-5001

REMARKS

Claims 1 – 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. RE38,127 E to O'Sullivan (hereinafter "O'Sullivan"), in view of U.S. Patent No. 5,526,403 to Tam (hereinafter "Tam"). Applicant notes that claims 1 – 28 are pending, but that the Examiner has cited only claims 1 – 27 in the Office Action Summary.

Claims 1, 2, 11, 13 –19, 21 – 24, 26 and 27 have been amended. No new matter is added. A number of the amendments are to address minor typographical issues. Other of the amendments have been made to more clearly articulate aspects of the claimed subject matter. Support for the latter amendments is found in the specification, for example at paragraphs [0033] – [0036] and [0039].

A. The Law

MPEP § 2143 sets forth the basic requirements for the Patent and Trademark Office to establish prima facie obviousness as follows: "To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." See MPEP § 2143.

B. Combination of *O'Sullivan* and *Tam*

All pending claims were rejected over the proposed combination of O'Sullivan and Tam. The Examiner stated that "it would have been obvious ... to modify O'Sullivan and Tam system, such that a hybrid device for enabling telephony communications landline/wireless connection path between said landline/wireless communications network and switch to select landline or wireless connection, to provide means for the convenient of the users converting/switching direction using hybrid communication device." (Office Action, Page 3). However, the first element of a prima facie case of obviousness is not met by the Examiner's statement because the Examiner has failed to allege any motivation, other than some vague and unsupported "convenience" for one of ordinary

Application No. 10/688,370
After Final Office Action of January 9, 2006

Docket No.: 03-5001

skill in the art to have combined O'Sullivan and Tam. Indeed, the Examiner has not shown in any reference where a combination is suggested or where an alleged motivation is found. For at least this reason, the rejection of all pending claims should be withdrawn.

Further, the Examiner has not shown that one of ordinary skill would have had a reasonable expectation of success for the combination as required to state a prima facie case of obviousness.

Thus, for at least these reasons, and the reasons set forth below, the Examiner has not carried the burden of a prima facie case of obviousness as required by MPEP § 2143. Accordingly, the rejections should be withdrawn.

C. Independent Claim 1

O'Sullivan and Tam do not teach or suggest all of Applicants' claim limitations, which is a further independent reason why the Examiner has failed to meet the burden of a prima facie case of obviousness and all pending claim rejections should be withdrawn. O'Sullivan includes a laptop device for a personal computer, a cellular transceiver, a speakerphone, and a hybrid communications control unit. The device has connectors for attaching a headset, a cellular control unit, a land telephone line, and additional speakers and microphones. (See O'Sullivan, Abstract). Tam includes a wireline interface permitting a cellular telephone receiver to originate and receive calls using both cellular and wireline services using a subscriber unit. (See Tam, Abstract). However, neither O'Sullivan nor Tam teach or suggest "a plurality of hybrid devices" nor a "predetermined performance factor," as required by amended claim 1.

1. "a plurality of hybrid devices"

Claim 1, as amended, recites "a plurality of hybrid devices" that neither O'Sullivan nor Tam teach or suggest.¹ The use of multiple hybrid devices is discussed, for example, in paragraphs [0033] and [0034] and with respect to Figure 4. O'Sullivan teaches "A laptop device" and Tam teaches "a subscriber unit." (Emphasis added; See O'Sullivan, Abstract; Tam, Abstract). As such, both references teach the use of single units. Additionally, Tam teaches away from the recited

Application No. 10/688,370
After Final Office Action of January 9, 2006

Docket No.: 03-5001

“plurality of hybrid devices.” Tam states that “[t]he invention should allow a user to initiate a call or to be accessed through a single, ‘personal’ telephone number, regardless of whether the user is currently available through the cellular or landline network ... [and that the] subscriber’s personal information, such as speed-dial numbers, need only be input into the single device.” (Emphasis added; See Tam, Col. 2, Lines 14-17 and 41-42).

Thus, O’Sullivan and Tam teach single devices, rather than “a plurality of hybrid devices” as recited in claim 1. Thus, claim 1 is allowable on this basis alone.

2. “predetermined performance factor”

Claim 1, as amended, recites “selecting one of said wireless connection path and said landline connection path for an outgoing call based on at least one predetermined performance factor when said wireless connection path and said landline connection path are available.” (Emphasis added). See, for example, paragraph [0039]. Neither O’Sullivan nor Tam includes these limitations.

Tam discloses manual selection of wireless or landline communications using a “LINE” button 46. (See Tam; Col. 6, Lines 59 – 67; Col. 7, Lines 1 – 8). Tam also discloses manual configuration of a call forwarding service by a user who prefers to pay wireline charges for an incoming call. (See Tam; Col. 10, Lines 19 – 23). In Tam, the forwarding scheme is directed to an incoming call. Thus, Tam does not teach selection of a connection path for “an outgoing call” and “based on at least one predetermined performance factor,” as recited in claim 1.

O’Sullivan does not cure the deficiencies of Tam. Indeed, while O’Sullivan may teach multiple modes of operation (see O’Sullivan; Col. 14, Line 8 – Col. 18, Line 5), O’Sullivan does not teach or suggest “selecting one of said wireless connection path and said landline connection path for an outgoing call based on at least one predetermined performance factor when said wireless connection path and said landline connection path are available,” as claim 1 requires. O’Sullivan alludes to selection of an analog line for an incoming call based on priorities and monitoring the presence of accessories, e.g. speakers, headset, microphones etc., for routing incoming calls to the

¹ As noted below with respect to claim 26, the Examiner has never addressed the claim limitations including more than one device in the Final Office Action, dated January 9, 2006, or the prior Office Action, dated July 26, 2005.

Application No. 10/688,370
After Final Office Action of January 9, 2006

Docket No.: 03-5001

accessories if they are present. (See O'Sullivan; Col. 14, Line 55 – Col. 15, Line 14; Col. 15, Lines 1 – 8). However, O'Sullivan does not teach selection of a connection path for “an outgoing call based on at least one predetermined performance factor,” as recited in claim 1. Thus, claim 1 is allowable on this basis alone.

The combination of O'Sullivan and Tam does not disclose each and every limitation of claim 1, as amended. Further, as discussed above, the Examiner has not shown the other prima facie elements including a suggestion or motivation to combine the references and a reasonable expectation of success in the combination. Therefore, claim 1 is in condition for allowance. Further, claims 2 – 10 depend from claim 1. Thus, for at least the same reasons as claim 1, claims 2 – 10 are in condition for allowance.

D. Independent Claim 11

Claim 11 recites “at least two handsets” that, as stated above, neither O'Sullivan nor Tam teach. Additionally, claim 11 as amended, recites “an outgoing call” and selecting “based on at least one predetermined performance factor.” (Emphasis added). As discussed above, neither O'Sullivan nor Tam disclose these limitations. Thus, for at least the reasons stated above, claim 11 is in condition for allowance. Further, claims 12 – 17 depend from claim 11. Thus, for at least the same reasons as claim 11, claims 12 – 17 are in condition for allowance.

E. Independent Claim 18

Claim 18 recites “at least two user devices” that, as stated above, neither O'Sullivan nor Tam teach. Additionally, claim 18 as amended, recites “an outgoing call” and routing “based on at least one predetermined performance factor.” (Emphasis added). As discussed in detail above, neither O'Sullivan nor Tam disclose these limitations. Thus, for at least the reasons stated above, claim 18 is in condition for allowance. Further, claims 19 – 25 depend from claim 18. Thus, for at least the same reasons as claim 18, claims 19 – 25 are in condition for allowance.

F. Independent Claim 26

Claim 26 recites “multiple user devices” that the Examiner has failed to address in both the

Application No. 10/688,370
After Final Office Action of January 9, 2006

Docket No.: 03-5001

prior Office Action, dated July 26, 2005, and the Final Office Action, dated January 9, 2006. Indeed, both Actions are silent on the "multiple user devices" recited in claim 26. Further, the Examiner appears to be rejecting claim 26 based on the limitations of claim 18. Applicants again state that O'Sullivan does not teach "multiple user devices." The combination of O'Sullivan with Tam does not cure the deficiencies of O'Sullivan. As noted above with respect to claim 1, O'Sullivan and Tam either alone or in combination do not teach more than one device.

Moreover, claim 26 has been amended to more clearly articulate the step of determining if a wireless connection is available between the wireless network and one of the multiple user devices that the incoming call is directed to and then routing the incoming call to one of the multiple user devices from the landline network or the wireless network when the landline connection and the wireless connection are available. The claim also now more clearly recites the step of routing the incoming call from the landline network to one of the multiple user devices via the wireless connection when the landline connection is not available.

Thus, for at least the reasons stated above, claim 26 is in condition for allowance. Further, claims 27 and 28 depend from claim 26. Thus, for at least the same reasons as claim 26, claims 27 and 28 are in condition for allowance.

Application No. 10/688,370
After Final Office Action of January 9, 2006

Docket No.: 03-5001

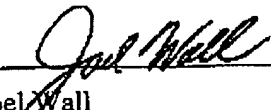
CONCLUSION

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 07-2347. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Respectfully submitted,

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